**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

42P6139CD

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Signature

Typed or printed  
name Susan McFarlane

Application No.

10/657,415

Filed

September 8, 2003

First Named Inventor

Carapella, et al.

Art Unit

3729

Examiner

Donghai D. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

NOTE: No more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under of 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- ☒ Attorney or agent of record.  
Registration Number 39,018
- ☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

  
William W. Schaal

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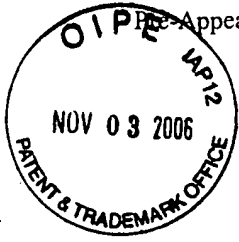
Telephone Number

November 01, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required.

☐ \*Total of \_\_\_\_\_ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application. No. : 10/657,415 Confirmation No. 9024  
Applicant : Elissa E. Carapella  
Filed : September 8, 2003  
TC/A.U. : 3729  
Examiner : Donghai D. Nguyen  
  
Docket No. : 42P6139CD  
Customer No. : 8791

Commissioner for Patents  
PO Box 1450  
Alexandria VA 22313-1450

REMARKS AND ARGUMENTS IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action dated August 1, 2006, Applicants respectfully request a Pre-Appeal Panel Review of the application.

**Remarks/Arguments** begin on page 2 of this paper.

### **REMARKS/ARGUMENTS**

This Amendment is in response to the Office Action mailed August 1, 2006. In the Office Action, (i) claims 42 and 43 were objected to under 37 CFR 1.75(c); (ii) claims 31, 32, 36, 37, 47 and 49 were rejected under 35 U.S.C. § 112 (second paragraph); and (iii) claims 17, 18, 31, 32, 41-45, 47 and 49 were rejected under 35 U.S.C. § 103.

Claims 42 and 43 have been cancelled without prejudice. Claims 31 and 36 have been amended to address alleged informalities raised by the Examiner. Claims 17-18, 31-32, 36-37, 41, 44-45 and 47-48 have been rejected. Claims 24-30 remain withdrawn. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Claim Objections***

Claims 42 and 43 were objected to under 37 CFR 1.75(c). Applicants have cancelled claims 42 and 43 without prejudice. Withdrawal of the objection is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 112***

Claims 31, 32, 36, 37, 47 and 49 were rejected under 35 U.S.C. §112, second paragraph. Applicants have amended claims 31 and 36 to correct minor informalities in the response to the Final Office Action dated October 30, 2006. Applicants believe that the outstanding §112 rejection has been traversed.

#### ***Rejection Under 35 U.S.C. § 103***

Claims 17, 18, 31, 32, 41-45, 47 and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lau (U.S. Patent No. 5,825,084) in view of Applicant Admitted Prior Art (AAPA). It is note that claims 36-37 have not been cited as being rejected under §103(a) but subsequent discussion is directed to these claims. Also, claim 29 is identified as allegedly being taught by the references, but no confirmation of claim 29 being reinstated has been received to date.

Presuming that claims 36-37 stand rejected under 35 U.S.C. §103(a) and claim 29 remains in withdrawn status, Applicants still respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).* Herein, at a minimum, the combined teachings of the cited references fail to describe or suggest *all* of the claim limitations. *Emphasis added.*

With respect to independent claims 17 and 31, Applicants respectfully submit that neither Lau nor the Admitted Prior Art teaches or suggests the following limitation:

removing a second portion of the conductive material along the inside surface of the bond shelf to form a pair of separate conductive strips along the inside surface of the bond shelf *with a first conductive strip of the pair of conductive strips coupled to a first bonding pad of the plurality of bonding pads coupled to a first power bus having a first voltage level and a second conductive strip of the pair of conductive strips coupled to a second bonding pad of the plurality of bonding pads coupled to a second power bus having a second voltage level less than the first voltage level, the first power bus and the second power bus are located in a same horizontal plane of the integrated circuit package.*  
*Emphasis added.*

Applicants respectfully submit that the Admitted Prior Art clearly states that “an integrated circuit may require both 3.3 V and 2.0 V power. The additional voltage level requires an **additional conductive power plane** within the package.” *Emphasis added; see page 2, lines 9-14 of the Specification.* Therefore, the combination of the teachings of Lau and the Admitted Prior Art teach a multiple power planes to support integrated

circuits of different voltage levels, which teaches away from the claimed invention that enables the establishment of multiple power busses within the same power plane.

Hence, it is respectfully submitted that the combined teachings of Lau and Admitted Prior Art do not establish a *prima facie* case of obviousness, and as a result, withdrawal of the outstanding §103 rejection is respectfully requested.

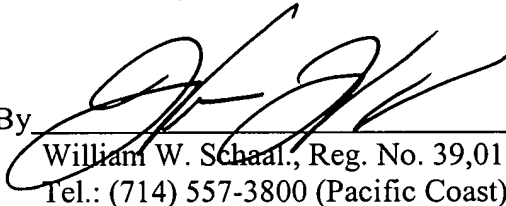
Applicant respectfully requests the Review Panel render a decision allowing the application.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: November 1, 2006

By

  
William W. Schaal, Reg. No. 39,018  
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Date: 11/1/2006

  
Susan McFarlane

11/1/2006

Date